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09/747,324	12/21/2000	Dong Myun Lee	9983.117US01	1289

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MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/747,324

Applicant(s)

LEE, DONG MYUN

Examiner

George C Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 1-19 are pending and have been examined.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

For example, the claims recite the limitations "user information" and "personal identifier."

Claim 1 recites:

"...verifying a user information based on the personal identifier information..."

Claim 1 also recites "...storing the personal identifier and user information." In view of these limitations, it appears to the Examiner that the "user information" and "personal identifier" are two distinct elements.

However, claim 2 recites:

"...storing unit stores a user information which represents a current connection state of a user..." Claim 2 further states "...said user information includes a personal

identifier...an internet protocol address...and an internet application service information."

The Examiner cannot resolve the similarities and/or differences between these two elements within the claim. It also appears that, in view of claim 2, the element "user information" has conflicting meanings and, on its face, is indefinite.

In view of the above, the Examiner will attempt to make a prior art rejection that is relevant to the claims.

### ***Claim Interpretation***

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for";
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

With respect to the first prong of this analysis, a claim element that does not include the phrase "means for" or "step for" will not be considered to invoke 35 U.S.C. 112, sixth paragraph. If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or (B) show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or

acts which would preclude application of 35 U.S.C. 112, sixth paragraph. See *Watts v. XL Systems, Inc.*, 232 F.3d 877, 56 USPQ2d 1836 (Fed. Cir. 2000)

The Applicant has not provided a clear definition for the terms "user information" and "personal identifier" recited in claims 1-19 within the specification. Therefore, the Examiner will interpret this element by its plain meaning as if the term was interpreted by one of ordinary skill in the art. See MPEP § 2111.01.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11 and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 161 008 A to Lee et al.

Regarding claim 1, Lee discloses in an apparatus providing a communication between users using a terminal connected with an internet network based on a connection with an internet service provider network by receiving a static internet protocol address or a dynamic internet protocol address, an apparatus providing a communication service based on a personal identifier in an internet network, comprising:

a user information management means connected with the internet network

for providing a unique personal identifier to a user and providing a communication service based on the personal identifier information (column 2, lines 19-45), wherein said user information management unit includes:

a user information service unit for verifying a user information ("user record") based on the personal identifier information and providing a service that a user wants ("calling"), to a user's terminal through the internet network (column 2, lines 19-45, specifically lines 30-32; column 21, lines 4-18); and

a user information storing unit connected with the user information service unit for storing the personal identifier and user information. (column 2, lines 19-45, specifically lines 35-36)

Regarding claim 2, Lee discloses the apparatus of claim 1, wherein said user information storing unit stores a user information which represents a current connection state of a user, wherein said user information includes a personal identifier of a user, an internet protocol address of a terminal which is currently used by the user, and an internet application service information which is currently used by the user for an internet application. (column 2, lines 19-26, 40-45, and 55-64)

Regarding claim 3, Lee discloses the apparatus of claim 2, wherein said internet application service information includes a mobile communication information including an identifier of a mobile communication terminal of a current user ("TID" or "terminal ID"). (column 5, lines 29-38; column 11, lines 11-32)

Regarding claim 4, Lee discloses the apparatus of claim 1, wherein said personal identifier is used in the same form as an existing domain name by combining a user

identifier and a domain name of the user information management means.

("tom@nortel.com"; column 5, lines 29-45)

Regarding claim 5, Lee discloses the apparatus of claim 1, further comprising means connected with the user information management unit for transferring a user applet to a user terminal and receiving the user information. (column 5, line 60-column 6, line 9)

Regarding claim 6, Lee discloses the apparatus of claim 1, wherein said user information management unit receives a user information from the user terminal which includes a personal information software for registering a user information. (column 5, line 60-column 6, line 9)

Regarding claim 7, Lee discloses in an apparatus providing a communication between users using a terminal connected with an internet network based on a connection with an internet service provider network by receiving a static internet protocol address or a dynamic internet protocol address, a method for providing a communication service based on a personal identifier in an internet network, comprising:

a user information service providing step in which an internet network is connected for providing a unique personal identifier to a user and providing a communication service based on the personal identifier information (column 2, lines 19-45), wherein said user information service providing step includes:

a first step for receiving a personal identifier information, a verification information ("user record") and a user information service request message from a user which are needed for a user verification; (column 2, lines 19-45, specifically lines 30-32)

a second step for verifying a user based on the personal identifier and verification information; (column 21, lines 4-18)

a third step for performing a user information service based on the type of each user information service request message ("calling"; column 21, lines 4-18); and

a fourth step for transferring a result message obtained based on an execution of the user information service to the user in accordance with the type of the user information service request message. (column 2, lines 19-45, specifically lines 40-45)

Regarding claim 8, Lee discloses the method of claim 7, wherein said user information service request message of the third step includes:

a user information management request message for requesting a user information management; a user information inquiry request message for inquiring the information of other user who the user wants to communicate; and a user information deletion request message for deleting a registered user information by a user information management request. (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15)

Regarding claim 9, Lee discloses the method of claim 7, wherein said third step includes:

a step for receiving a user information packet including a user information of the current user from the user terminal when the type of the user information



service request message is a user information management request; (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 9, lines 30-58)

a step for extracting and storing a user information and a personal identifier information of the user from the user information packet received; ("adding user records"; column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15) and

a step for generating a user information registration message which reports that the user information and the personal identifier information are registered. ("information response"; column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15)

Regarding claim 10, Lee discloses the method of claim 7, wherein said third step includes:

a step in which the user information registration unit receives a personal identifier of a user and a verification information needed for a user verification from the user terminal when the type of the user information message is a user information management request; (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 9, lines 30-58)

a step for verifying a user based on the personal identifier received and the verification information; (column 21, lines 4-18)

a step in which the user information registration unit transfers a user applet to the user terminal, and the user applet is performed; a step for receiving a user information packet including a user information of the current user from the user terminal based on the user applet; (column 5, line 60-column 6, line 9)

a step for transferring the received user information packet to the user information management unit; and a step for generating a user information registration message which reports that the user information and the personal identifier information are registered. ("information response"; column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15)

Regarding claim 11, Lee discloses the method of claim 7, wherein said third step includes:

a step for receiving a personal identifier of a user and a verification information needed for the user identification from the user terminal based on a connection with the user terminal including a personal information software when the type of the user information service request message is a user information management request; (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 9, lines 30-58)

a step for verifying a user based on the personal identifier and verification information; (column 21, lines 4-18)

a step for executing a personal information software of the user terminal; (column 5, line 60-column 6, line 9)

a step for receiving a user information packet including a user information of the current user from the user terminal based on the personal information software (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 9, lines 30-58); and

a step for generating a user information registration message which reports

that the user information and personal identification information are registered.

("information response"; column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15)

Regarding claim 15, Lee discloses the method of claim 7, wherein said third step includes:

a step for receiving a personal identifier of other user which is an object of the user information inquiry and an information with respect to the type of the internet application which will be serviced when the type of the user information service request message is a user information inquiry request; (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 9, lines 30-58)

a step for searching a user information of a user which is an inquiry object based on the received personal identifier information and the internet application service type information (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 10, lines 7-9); and

a step for generating a user information message based on the user information corresponding to the personal identifier. ("information response"; column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15)

Regarding claim 16, Lee discloses the method of claim 15, wherein said user information search step includes:

a step for searching a node identifier information corresponding to the internet application service type when the internet application service type information is an

Art Unit: 2143

inquiry request with respect to the internet application type; a step for searching a node identifier information corresponding to the internet application service type when the internet application service type is a request with respect to an inter-working with the internet application service; and a step for searching an identifier information of the identifier information of the node identifier information corresponding to the internet application service type when the internet application service type information is a connection request with a communication session. (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 10, lines 7-9)

Regarding claim 17, Lee discloses the method of claim 7, wherein said third step includes:

a step for receiving a personal identifier information of a user and a user information from the user when the type of the user information service request message is a user information deletion request; ("deleting user records"; column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 9, lines 30-58)

a step for searching and deleting a personal identifier and a user information corresponding to the personal identifier information and user information received from the user (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 10, lines 7-9); and

a step for generating a user information deletion message which represents that a user information of the user is deleted. ("information response"; column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15)

Regarding claim 18, Lee discloses the method of claim 7, further comprising:  
a step for searching a mapping relationship information of the type of an internet application and a node identifier information with respect to a personal identifier of other user which is an object of the inquiry when the user information service request message type is an internet service inter-working request among the user information inquiry requests when transmitting a result message in the fourth step (column 7, line 63-column 8, line 11; column 9, line 30-column 10, line 15, specifically column 10, lines 7-9); and

a step for connecting the user's terminal which requested an inquiry through the mapping relationship information to an internet application service of the other user.  
(column 21, lines 4-18)

Regarding claim 19, Lee discloses the method of claim 7, further comprising:  
a step for searching a mobile communication service type of the current user based on the type of the internet application with respect to a personal identifier of other user which is an object of the inquiry when the type of the user information service request message is a request of a connection with a communication session among the user information inquiries when transferring a result message in the fourth step; (column 5, line 60-column 6, line 9; column 21, lines 4-18)

a step for searching an identifier information of the mobile communication terminal based on the mobile communication service type through the node identifier information of other user; (column 5, lines 29-38; column 11, lines 11-32)

a step for connecting with a communication system using an identifier information of the mobile communication terminal; a step for setting a communication session to the mobile communication terminal based on an inter-working with the mobile communication network through the gateway of the internet; and a step for connecting the terminal of a user who requested an inquiry through the communication session and the mobile communication terminal. (column 21, lines 4-18)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al.

Regarding claim 12, Lee discloses the method of claim 9, wherein said user information packet (column 14, line 40-column 15, line 17; column 15, lines 50-57) includes:

a dialing side internet protocol address which represents an internet protocol address of a terminal of the current user (column 11, lines 11-32);

an incoming side internet protocol address which represents an internet protocol address of the user information management unit for receiving the user information packet ("TID");

a personal identifier which represents a user's personal identifier ("PID");

an internet application type which represents the type of the internet application operated by the user; and a node identifier information which represents an internet protocol address information based on the type of the internet application.  
(column 5, line 60-column 6, line 9)

Lee does not disclose a private/public network flag which represents whether the terminal of the user exists in a private internet protocol network or in a public internet or a terminal internet protocol address which represents a public internet protocol address of the terminal in the case that the terminal exists in the public internet and which represents a public internet protocol address allocated to a gateway which connects the private network and public internet network when the terminal exists in the private internet protocol network, however, Lee does suggest that the terminal of a user may be on a public or private network using the internet protocol and the IP addressing system (column 3, line 53-column 4, line 9; column 5, lines 13-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a flag and terminal addresses to denote whether a user is on a public or private network because, based on the suggestion by Lee that a user

may be on a private or public network, the invention of Lee would have to contain functionality that would enable the invention to reach a user on a private or public network through the use of private or public internet protocol addresses and some sort of indication that the user is on either network. Therefore, it would have been obvious to achieve the limitations as claimed.

Regarding claim 13, Lee discloses the method of claim 12, wherein said internet application types and node identifier information are provided in multiple numbers based on the number of the internet applications operated by the user. (column 5, line 60-column 6, line 9)

Regarding claim 14, Lee discloses the method of claim 12, wherein said type of the internet application includes a mobile communication type of the current user, and the node identifier information further includes an identifier of the mobile communication terminal. (column 5, lines 29-38; column 5, line 60-column 6, line 9; column 11, lines 11-32)

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6 616 035 B2 to Ehrensvard et al.

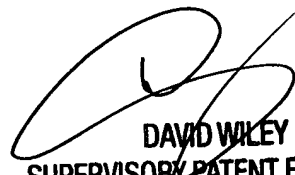
Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C Neurauder, Jr. whose telephone number is 703-305-4565. The examiner can normally be reached on Thursday 1-2pm EST.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn



DAVID WILEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100